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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,916	05/15/2001	Richard J. Larson JR.	06155-063001	1138
26161	7590	12/02/2003	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			ZIMMER, MARC S	
			ART UNIT	PAPER NUMBER

1712

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,916

Applicant(s)

LARSON ET AL.

Examiner

Marc S. Zimmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,9-16,18-20,23-26,35-38 and 43-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11,12,16,18,19,23-26,45,46,49,52-57,59-66,68-77,79,80,87-90,93 and 94 is/are allowed.
- 6) ☒ Claim(s) 1-4,9,10,13,14,20,35-38,43,44,46-48,50,51,58,67,78,81-86 and 95-98 is/are rejected.
- 7) ☒ Claim(s) 91 and 92 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 9-10, 13-14, 20, 35-38, 43-44, 47-48, 50-51, 58, 67, 78, and 81-86 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In the Examiner's last Office action, it was indicated that the Applicant did not have express support in their Specification to support the added limitation that the stated ratio of phenyl to methyl groups in the aforementioned claims was a weight ratio. At the same time, it was pointed out that page 9 of the Specification identified numerous commercial products that were exemplary of the silicone containing methyl and phenyl groups but there was not sufficient information as to the precise structural attributes of these materials to provide a basis for support hence Applicant was required to furnish structural information for these compounds, e.g. in the form of a product data sheet.

Curiously, Applicants have now reversed themselves claiming instead that the ratio in question is a molar ratio as opposed to a weight ratio. In this connection, they allege that the mention of the supplier and CAS number provides adequate support of this concept. The Examiner adamantly disagrees. An attempt was made to determine the chemical constitution of a couple of the polymers (CAS Registry Nos. 68037-90-1

and 25766-16-9) by performing a search on STN of the registry numbers. However, the results of this search were uninformative as can be seen from the enclosed data retrieved from the search. Applicant must provide evidence that the polymers recited on page 9 do, in fact, possess the molar ratio of methyl-to-phenyl groups stipulated by these claims. They might consider demonstrating that this ratio is supported by providing ^1H NMR data from a couple of representative compounds that shows the integrated areas for the phenyl and methyl protons of the compound.

Claims 1-4, 9-10, 13-14, 35-38, 43-44, 47-48, and 50-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended independent claims 1 and 35 such that they now require the silicone resin to be devoid of alkoxy groups. However, there is nothing in the original disclosure that particularly excludes these groups. Indeed, in the most limiting description of the polymer component, only the following features are delineated:

- (i) the resin belongs to the genus of compounds known as silicones,
- (ii) said silicone resins bear both methyl- and phenyl substituents, and
- (iii) the methyl- and phenyl groups must be made available in relative quantities that satisfy a mandated molar ratio. Notably, it still has not been demonstrated that this requirement is supported by the original disclosure.

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In view of these facts, the added limitation is deemed new matter and should be removed from the claim(s).

Applicant is advised that, should they amend the claims only by removing the new matter, claims 1-4, 9, 13-14, 35-38, 43, 47-48, and 50 will be once again subject to rejection over *Koerner*.

It is noted for the record that “new” claim 95 is merely a restatement of original claim 6 and new claim 98 mirrors once-amended claim 1 in every respect except that the stated ratio is a molar ratio.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 81, 85, and 86 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Koerner et al.*, U.S. patent # 4,749,764. Whereas independent claims 1 and 35 have been amended to state both that the ratio of phenyl-to-methyl groups is a molar ratio and the silicone is devoid of

alkoxy groups, claim 81, and hence claims 85 and 86, have only been modified such that the ratio is a molar ratio and not a weight ratio. The more specific embodiments of the homologous component taught by *Koerner* that are depicted in column 3 clearly satisfy this limitation hence Applicant's amendment does not overcome the reference. (In retrospect, *Koerner* may have been misapplied previously as it would seem to anticipate Applicant's invention only where the stated ratio is a molar ratio.)

It is further appreciated that the rejection over *Koerner* should have been made under 102/103 because the behavior exhibited by the silicone when it is contacted with energy is not expressly or impliedly mentioned by the reference. A rejection under 102/103 is appropriate however because, as was pointed out before, one of ordinary skill would expect any compound containing hydrocarbon moieties to degrade to elemental carbon if the irradiation source were sufficiently energetic. (Notably, claim 81 does not even require that the energy be light energy but it is presumed that this is the only form of energy that may be used to create patterned indicia.)

Claims 95-98 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Koerner et al.*, U.S. Patent # 4,749,764. The polymers outlined in column 3 of the reference satisfy all of the structural limitations of the silicone set forth in claims 95-98. The multifunctional alcohol (column 3, lines 61-68) anticipates the chain extender contemplated in claim 95. Again, this composition will inherently undergo the required change given a sufficiently energetic light source.

The rejections over *Schonfelder* are hereby withdrawn in view of Applicants statements.

Allowable Subject Matter

Claims 1-4, 9, 13-14, 35-38, 43, 47-48, and 50 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first paragraph provided that Applicant identifies a way to render claims 1 and 35 over Koerner. Claims 10, 20, 44, 58, 67, 78, and 82-84 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first paragraph.

Claims 91 and 92 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 11-12, 16, 18-19, 23-26, 45-46, 49, 52-57, 59-66, 68-77, 79-80, 87, 88-90, and 93-94 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

November 21, 2003

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A handwritten signature in black ink, appearing to read "Robert A. Dawson". The signature is fluid and cursive, with a large, stylized initial 'R'.

Robert Dawson
Supervisory Patent Examiner
Technology Center 1700